

**REMARKS**

The pending Office Action indicates a review of claims 92, 95 and 97.

Our present understanding is that claims 93, 95, 97 and 102 are pending in the application.

It is noted that Claim 92 was canceled in our previous Amendment and its contents amended into claim 93. Claim 102 was also added in our earlier Amendment.

Claims 95 and 97 are amended herein to correctly depend from independent claim 93.

New claim 103 is added and substantially mirrors independent claim 102. New claims 104, 105, and 106 are added to claim an additional feature of the present invention.

Claims 93 and 102 are parsed and amended solely for clarity and to ease reading and review. It is noted that in the parsed form it may be easier for the Examiner to consider the multiple elements under review.

At present, after entry, claims 93, 95, 97, 102, 103, 104, 105, and 106 are pending.

Favorable reconsideration is respectfully requested in view of the enclosed amendments and the following representations. It is requested that acknowledgment of the above claim status is noted in any subsequent communication from the USPTO.

The specification is amended to insert the established priority claim. No new matter has been added. Support for the amendments is found in the original claims, specification, and drawings.

**1. Rejection of Claims under 35 U.S.C. § 112, Second Paragraph**

It is noted that claim 93 is pending in the present action and not claim 92. A response to comment item 1 is noted below. It is respectfully proposed that the parsing of claims 93 and 102 may aid in the visual review of the claims and has been conducted for that reason alone.

In response to the Examiner's concerns with claim 92, line 12, it is proposed that as now parsed,

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the language of claims 93 (previously incorporating claim 92) and 102 dealing with “closed-end and an open end” is easily understood.

Namely, present lines 7-8 of claim 102, include the following phrase “a sleeve comprising a one-piece unitary construction formed with a tubular body having a closed-end and an open end”. In parsing this passage according to common English language usage, it is proposed that it is clear the sleeve has a tubular body, and that since the tubular body is the last noun precedent the phrase in question, it is this tubular body that has the closed-end and an open end. Any other interpretation would be tortuous.

In response to the Examiners concern of lines 2-3 in claim 97 “said double-ended tool” it is noted that the specific language of claim 97 introduces and defines a double ended tool bit, and that the next phrase simply repeats this phrase. A minor correction has been added for yet further clarity.

## 2. **Claim rejections under 35 U.S.C. §103(a)**

### **HINDSIGHT IS THE SOLE POSSIBLE BASIS FOR THE REJECTION UNDER §103**

**Harrison, the principal reference teaches:**

1. **That the double ended sleeve 152 must necessarily be a (i) removable and (ii) non-handle, and teaches away from an in-sleeve-in tool storable tool bit construction.**
2. **The sleeve 152 being open at each end required for insertion over a separate driver tool and to receive a single ended tool bit 168, 140, 142, 160, 164 etc.**
3. **The storage of tool bits 168 outside the handle separate from the sleeve.**
4. **The use of only single-ended tool bits 168.**
5. **The sleeve 152 is removable from a screw driver tool 110 fixedly otherwise operably mounted on a narrow shaft 118.**
6. **The sleeve 152 being is necessarily removable for alternative use with a side of the driver tool 20 and extension bit 148 and others.**

**Harrison teaches away from the present invention in at least the following respects.**

1. **In-sleeve, in-toolbody-stowable tool bits.**
2. **The sleeve is double-ended, removable and pouch-stowable and teaches away from a closed-ended fixedly disposed sleeve.**
3. **Tool bit storage in the sleeve body.**

4. Double-ended tool bits.
5. The Examiner's explicit suggestion to fix a sleeve in Harrison is impermissible in that it (i) renders tool 110 inoperable, (ii) renders the double-ended sleeve functionality inoperable, and (iii) renders the square body tool bit combinations inoperable.

Beran, the supporting reference, teaches and provides for:

1. The use of only flat thin cutting tools 56, 42, 28, not torque tool bits.
2. The three-sided socketed adaptors 36, 51, 33 have only a narrow rectangular shape providing only a single vector of support for cutting action and the cutting tools.
3. New "means of which the individual cutting implements can be removed and replaced as may be found necessary" (col 1, ln 39-51).
4. Socket adapters with one elongated side and one non-elongated side, which precludes torque application.
5. A narrow gripping tool body.

The teachings of Beran teach away from the present invention in at least the following respects.

1. The Beran cavity is designed only for receiving thin cutting blades, not torque applied tool bits.
2. A sleeve for receiving a hexagonal bit in a hexagonal cavity.
3. It is clear that Beran is only suitable for cutting and for linear operability generating only linear forces. Beran is wholly inoperable for and incapable of withstanding torque forces necessarily generated by torsional tool bit use.
4. Beran teaches and requires the outer surface of the socket shaped cavity to have a significantly longer upper side than the opposite lower side. The longer side being the required supporting and bearing side to exert a downward force on the cutting blade. The shorter opposite side serves to expose a maximum amount of cutting or sawing edge.

Beran is inoperable and unusable with (1) hexagonal body tool bits, and (2) any tool bit use requiring torsion or torque forces along a tool bit axis. Beran contains no teaching of and is unrelated to (1) hexagonal tool bit storage (containing only blades), (2) a wing member support extended on a fixed non-removable sleeve for hexagonal cavity for hexagonal bits, and (3) the application of any type of torque forces through the socketed adaptors holding the bladed tools.

Harrison and Beran each clearly require that the sleeve be specially adapted solely to

**receive the item shown (thin blades for Beran and single ended bits for Harrison); there is no suggestion or ability to combine absent substantial hindsight modification.**

Park, the other reference relied upon to provide tool bit storage in a handle instead teaches the following principals.

1. **Tool bit storage in a separate compartment unrelated to the tool bit driver.**
2. **Requiring the socket to be removed and an unrelated separate compartment to be opened to remove a new tool bit and receive the now-unused bit.**

**Harrison, Beran, and Park disclose diverse elements. Harrison, Beran, and Park teach away from the invention in several principal respects. Applicants respectfully suggest that the Examiner fairly and fully re-read the references with the foregoing in mind, in that it is the complete reference that is the disclosure. It is well established that the Examiner cannot pick and choose various reference elements, pluck them from an opposing context, modify and reconfigure them to fit an argument generated solely from hindsight (and opposing teachings of the reference themselves), and force fit these elements into an argument employing no other suggested basis for support and requiring additional modification.**

**It is noted that there are only two possible types of teachings in a reference to suggest modification or combination, (1) explicit and (2) implicit. It is tacitly conceded by the Examiner that there is no explicit suggestion to combine the references. Since each of the applied references teaches a separate solution to their own self-defined problem and lacks any discussion of alternative solutions there can be no logically implicit suggestion for combinability other than from impermissible hindsight. In view of the above, Applicants respectfully propose that they have overcome the Examiner's alleged *prima facie* obviousness, and request reconsideration supporting the allowability of the pending claims.**

**Item 3 (page 2) and item 4 (page 5)**

The Examiner admits that Harrison fails to disclose a closed end of the sleeve being non-removably connected to the means for pivotally connecting, and yet the Examiner asserts that Harrison's adaptor 152 (col. 8 ln. 28-44) has a wing member "118" somehow extending from the outside of the tubular body 152 (Fig. 17). This is clearly false. Wing member "118," actually shank 118 (col. 3, ln. 47), is not part of the "tubular body." and therefore cannot be "non-removably connected" and cannot "extend from". Consequently, the asserted wing member "118" cannot be formed with the tubular body as is required with the claim.

The Examiner also asserts that Beran discloses "bits and sleeves stored in the handle" and cites no portion of the Beran reference. This assertion is incorrect. Beran is formed as a narrow rectilinear body, for storing blades 56, cutters 42 or saw blades 28. The entire Beran disclosure is focused on cutting items and rasps. There is no known mention of "bits and sleeves stored in the handle." It is impermissible hindsight reasoning to read tool bits as claimed into this art with a fair reading of the reference. Applicants respectfully suggest that the Examiner's speculation on the contents of Beran is not supported.

Regarding the Examiners assertions of obvious to combine and modify, Applicants respectfully and seasonably traverse the Examiners suggestion of well known and obvious to combine statements found within the instant action under MPEP §2144.03. No clear citation of teaching to combine was found or cited by the Examiner in either reference. A seasonable demand constitutes a demand for evidence made as soon as practically possible during prosecution. As such, this opportunity to rebut and provide clear supportive evidence is made timely and cannot be avoided. Applicants note that no such teaching or motivation exists in the references and none has been cited. Each reference successfully reaches it's own conclusion to the problem presented and meets its own needs in the solution of that problem.

It is noted that "if official notice is taken of a fact unsupported by documentary evidence the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable."

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MPEP 2144.03(B). Applicants have challenged the Examiner's assertion of "obvious to one skilled in the art to combine" as not being "clear and unmistakable" and lacking support from the references cited alone or in combination. Where an "applicant challenges a factual assertion as not properly officially noticed or not based upon common knowledge the examiner must support the finding with adequate evidence". MPEP 2144.03 (C). Consequently, Applicants official request a written document in the form of a signed affidavit or declaration setting fourth specific factual statements and an explanation to support the finding of "obvious to one skilled in the art." MPEP 2144.03 and 37 C.F.R. 1.104(d)(2). It is noted that an Examiner's unsupported written assertion of what would have been obvious has been found inadequate to support or maintain an obvious rejection.

"It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based" *Surko* 258 F.3d at 1386 and MPEP 2144.03(D)

It is proposed that in addition to the later date of Harrison, voiding Harrison as a reference, neither Harrison, Park, nor Beran include a teaching or suggestion to combine, much less (after combined with all necessary modifications) all the elements and limitations claimed. Citation to specification citations of teachings to combine or suggestions to modify the remaining references (Beran and Park) have not been provided. Consequently, Applicants propose that they have overcome the rejections of claims 93, 95, 97 and any possible rejection of pending claim 102 based on the present references.

In item 4, the Examiner asserts that claim 97 is rendered obvious in light of Park. The Examiner asserts that Park is relied upon to disclose a double ended bit. While Park 's bit 33 may have two ends, the Examiner then relies upon a non-existent, and non-cited teaching or suggestion to combine the double ended tool bit 33 of Park with the necessarily single ended tool bit of Harrison and the no tool bit blade of

Beran. This assertion on its face fails to make out a *prima facie* showing under §103.

Combining, via substitution, the double-ended Park tool bit 33 with the shorter tool bit 168 of Harrison (Fig. 17) while forcing the resultant bit into the thin Beran sheath (rupturing the sheath), and would require an additional impermissible physical modification of the Harrison and Beran constructions.

Reconsideration and withdrawal of the pending rejections is respectfully requested.

**Item 5 (page 3)**

Regarding the Examiner's assertion of non-persuasiveness of Applicants' previous argument, Applicants respectfully respond by noting MPEP 2144.08 "if the evidence is deemed insufficient to rebut the *prima facie* case of obvious the Office personnel should specifically set forth the facts and reasons that justify this conclusion." While Applicants have carefully reviewed the total of five (5) lines following the Examiner's comments of unpersuasiveness, they have been unable to find any specific facts or reasons justifying the Examiner's conclusion. Applicants seasonably request a specific rebuttal citing support clearly from the references themselves as is required by office procedure in MPEP 2144.08. Applicants respectfully assert that the References fail to support the Examiner's assertions and that the Examiner has not responded as required by the MPEP.

The Examiner also asserts the combination of the Harrison and Beran constructions but fails to address the basic suggestions or motivations and the clear inoperability of such a combination. The Examiner has failed to consider that the teachings of Harrison are not suggested in Beran and the teachings of Beran are not suggested in Harrison, and that the required inoperability and required redesign of the suggested combination. There is, consequently, no *prima facie* showing under §103. As discussed above, the Examiner has also failed to note any teaching or modification language in Beran or Harrison suggesting that the limited disclosures be modified as necessitated by the Examiner to encompass the required limitations of the claims.

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Since Harrison is not applicable as blocking art, and since the Examiner's own assertions note the elements missing from Beran, it is proposed that a *prima facie* obviousness rejection has not, and because of this underlying reasoning, cannot be established with the pending references.

As noted in MPEP 2145 (I), arguments of counsel cannot take the place of evidence in the record. It is also clear that the arguments of the Examiner cannot take the place of evidence not in the record MPEP 2144.08. Unfortunately, the record is replete with instances of the Examiner arguing what would be obvious without citing evidentiary support from the references cited and further requiring modifications and changes to the combination of references to meet the limitations as claimed.

The Examiner asserts that "one cannot show nonobviousness by attacking the references individually" and cites *In re Keller* and *In re Merck* (from MPEP 2145 (IV)). This assertion is incorrect. The Examiner's assertion is not a full and complete statement of an Applicant's clear right attack the references themselves, the Examiner-asserted teachings, and combinations thereof. The burden is upon the Examiner to specifically support a prima facie showing of non-obviousness citing not hindsight fanciful combinations, but clear findings from the references, lacking in this case. Should this showing be lacking, there is no burden to respond upon the applicant. Second, this assertion is false since the Examiner's quotation, direct from MPEP 2145 (IV) is not applicable to the present circumstances under MPEP 2142, 2143, and 2143.01. It is suggested that this grounds for rejection are moot in light of the clear showing of no suggestion for combinability and the multiple inoperability of the Examiner suggested combinations.

MPEP 2144.08 and others clearly require that the references cited must include claim limitations and teaching or suggestion to combine with other references within the references themselves. Each of the arguments to combine or modify provided by the Examiner either fail to show a teaching to combine (i.e. the end result would be better/stronger/more capable etc.) or are lacking an element as claimed. Consequently the above noted statement and the rejection itself is inappropriate. Using the Examiner's

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present analysis, Applicants suggests that President Lincoln's Emancipation Proclamation would have been obvious simply because each of the words used were available in a dictionary.

Should the cited quotation (*In re Keller*, *In re Merck*) be cited in the future, Applicants specifically request the Examiner's specific citation as to which attack on a reference is missing a link to either a missing element/limitation or to a missing teaching, suggestion, or motivation to combine, that the Examiner asserts has been provided.

It is noted that MPEP 2144.08 (III) requires that each finding should clearly articulate which portions of a reference support any rejection. Explicit findings on motivation or suggestion to select should be articulated to support a §103 ground for rejection. Here, these findings and motivations are missing. MPEP 2144.08 (III) specifically states that “[c]onclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings.” Applicants suggest that the present action fails to provide “articulated rationales or evidentiary support”

Reconsideration and withdrawal of the present rejection is respectfully requested.

#### **Item 6 (page 4)**

The Examiner asserts that it is mandatory to update the status of the parent applications on page 1 of the specification. Such an amendment is provided herein. It is noted that the status of the parent applications is clearly shown in the records and on the face of the published application itself. See US 2002/0069729A1. It is also noted that the present status of all but one of the parents to the present application is patented.

#### **3. The Wing Member Limitations**

When evaluating the scope of a claim, every limitation in the claim must be considered and found in the references without requiring additional modification. MPEP 2144.08(I) citing *In re Ochiai*, 71 F.3d

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1565, 1572. Here, the references alone, or when combined exclude at least the following clearly noted claim limitations, restrictions, mandatory positions or physical relationships required in at least one of the independent claims (claim 93, 102, and 103).

1. The “wing member” (member having oppositely disposed flat surfaces), as shown and claimed, is not formed with the tubular body.
2. The wing member must include oppositely disposed flat surfaces as shown and claimed.
3. The wing member must extend away from the outside of the tubular body, as shown and claimed.
4. A tubular body being tubular as shown and claimed. i.e. resembling a cylindrical “tube”
5. The tubular body being joined to (a) the wing member and (b) the means for pivotably fixing.
6. The means for pivotally fixedly connecting must be fixed to the sleeve in a non-removable manner.

As asserted by the Examiner, should the tubular body 152 of Harrison be modified in some undefined manner to include as a “wing member” extension 118 fixably extending away from the outside of the tubular body 152, Harrison would cease to function as required by the claims. Specifically, tool bit head 166 and screw driver shaft 110 (Fig. 17) would cease to exist, eliminating a required function of the reference. More importantly, the Examiner’s suggestion would require additional modification of Harrison to cut off screw driver shaft 110 and weld on tube body 152, eliminating the required opening 150 further voiding the requirements found in the reference and narrowing the set-depth of single-ended bit 168. Further, the handle body 20 in Harrison would have to be modified (broadened and lengthened), as would to fit the Examiner’s asserted modification. In each case, the Examiner’s assertions require additional impermissible modification of the references.

**4. The Sleeve Limitation**

Beran discloses a rectilinear/rectangular socketed adaptor 36, 31, 51 etc. for removably receiving a thin-planar member, viz shank of a saw 28, cutter 42, blade 56 each with a fixing pin/set screw 35, 47, or 58. Beran is built to specifically allow the removal of narrow bladed items only. Beran's socketed adaptors are necessarily rectilinear and must have one side longer than the other. The longer or back side of each socket has a single bearing or supporting surface for supporting one side only of the thin-planar member. The longer or back side of each socket mandates a single direction and orientation for blade insertion. The present invention requires a bearing surface at the open end of the cylindrical tubular body positioned perpendicular to the centerline of the sleeve member. Beran's socket's clearly teach away multi-sided bearing surfaces receiving multiple orientation tool bits.. Beran's socket is only designed to transmit a cutting pressure back to a handle member. If a twisting torque were applied to Beran's socketed adaptors, or their thin-planar members, each would twist, bend, and fail.

The Applicants' salient teaching is not disclosed, not suggested, and indeed contrary to the prior art. The Applicants' teaching is a closed ended cylindrical sleeve pivotally fixedly connected to a pliers handle for transmitting torque forces to a tool bit.

Consequently, a hexagonal cavity is antithetical to Beran. The Examiner's assertions would require modification of the "closed end" provided by Beran to:

1. Reconfigure the socketed adaptor 36, 31, 51 to become the tubular body 152 from Harrison
2. Form the socketed adaptors into a tubular body, voiding the operability of both Beran and Harrison since they will no longer be fittable within their respective cavities.
3. Form the opening in the rectilinear body into a cylindrical opening.
4. Form the outer surface of the opening of the rectilinear opening into a planar surface perpendicular to a centerline of the

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5. Modify the fixing ends of the saw 28, cutter 42, and blade 46 to lock into a now cylindraceous opening in the now cylindrical tubular body.
6. Remove the set screws/fixing pins 35, 47 and 58.

In sum, a double ended tool bit in a sleeve is far removed from the Beran construction.

Further, despite the lack of written evidence (allegedly existing in the references, but actually missing) to combine, if the references were to be combined, at least the following additional modifications would be required before the combination would work as presently claimed.

1. The body and hinge portions of Harrison and Beran must be reconfigured to accept some new type of tubular body (this modification is unsupported and required for operability)
2. The side walls must be included in some way with Park for the now-modified tubular body with the permanently fixed wing member to attached to a differently positioned hinge portion.
3. The now revised hinge portion from Park, Harrison, or Beran must be operably joined to revised leaf springs within the body to enable a pivoting removal of the tubular body from within modified side walls supported by the urging force provided by the now modified leaf spring.

If the objections are maintained despite Applicants' amendments and seasonable traversal of the *prima facie* rejection and request for supportive written documents capable of review and rebuttal by experts on appeal, Applicants specifically request under MPEP §2163.04, that the Examiner provide both written notice, in an affidavit 'offer of proof,' that establishing the ordinary skill in the art based on the Examiners personal knowledge, and that those ordinary skill in the art would find each and every one of the necessary redesign modifications noted above as obvious to one skilled in the art absent impermissible hindsight reasoning.

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Applicants note that it is the prior art itself that “must provide the motivation or reason for the worker in the art, without the benefit of [applicants] specification, to make the necessary changes in the reference device.” MPEP 2144.04 (C).

Finally, Applicants note that where a suggestion of desirability exists, the proposed modification can neither (1) render the prior art unsatisfactory for its intended purpose after modification, see *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), MPEP §2143.01, nor (2) change the principle of operation of the reference *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959), MPEP §2143.01. Here, Applicants make clear that the modifications necessitated by the Examiner would both render the prior art unsatisfactory for its intended purpose and change the prior art construction and principal of operation.

Applicants respectfully submit that the combination of references, proposed by the Examiner, neither teach or suggest, all of the claim limitations of the present invention, nor provide a suggested desirability for the necessary modifications and additions, nor provide a reasonable expectation of success without further modification. Reconsideration and withdrawal of all rejections is respectfully requested. In view of the foregoing (including claim amendments), the application is now believed to be in proper form for allowance and notice to that effect is earnestly solicited.

Applicants respectfully propose that they have responded to each and every rejection and objection raised by the Examiner in this case. While Applicants have respectfully disagreed with the Examiner’s rejection of the claims for the above reasons, Applicants have elected to amend the claims to still more clearly set forth the invention, and solely for the purpose of clarifying the patent application process in a manner consistent with the PTO’s Patent Business Goals (PBG), 35 Fed. Reg. 54603 (September 8, 2000). Therefore, it is proposed that this amendment does not narrow the scope of interpretation for the claims.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or to credit any overpayment related hereto, to Deposit Account No. 010-0100.

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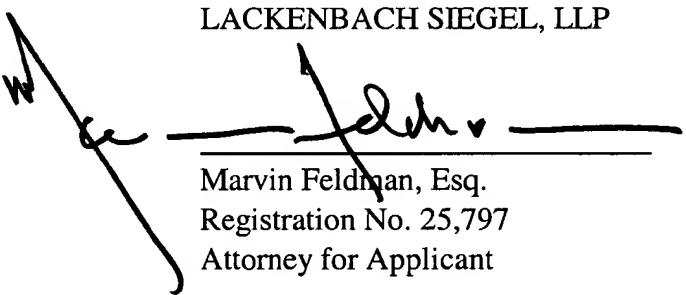
No new matter has been added.

Applicants respectfully submit that they have overcome and rebutted the Examiner's prima facie obviousness rejections. In the spirit of condensed and streamlined practice, if the Examiner believes that a telephone conference would be of value to place the application in condition for allowance, the Examiner is respectfully requested to call the undersigned counsel at the number listed below for resolution of any remaining issues.

An early and favorable action is respectfully solicited.

Respectfully Submitted,

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Note: A "Clean Copy" is no longer required and is not attached

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**MARKED-UP VERSION****IN THE SPECIFICATION**

On page 1, after the Title and before the main body, kindly insert the following:

~~The present application is a continuation of US App. No. 09/237,557, filed Jan. 26, 1999, now patented, which is a continuation-in-part of US App. No. 08/904,666, filed Aug. 1, 1997, now patented which is a continuation-in-part of US App. No. 08/620,471, filed on March 22, 1996 abandoned, and which is a continuation-in-part of US App. No. 08/451,398 filed May 26, 1995, now patented.~~

*Include part 1*